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23719 7590 05/09/2007 KALOW & SPRINGUT LLP 488 MADISON AVENUE 19TH FLOOR NEW YORK, NY 10022			EXAMINER HUTTON JR, WILLIAM D	
			ART UNIT 2176	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/766,067

Applicant(s)

GRAHAM ET AL.

Examiner

Doug Hutton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 28-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 28-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Applicant's Response

In Applicant's Response dated 09/15/2006, Applicant amended Claims 1, 2, 6, 7, 12-20, 25, 28-36, 39-41, 46, 51-59, 64, 65, 67-75 and 78, added new Claims 79-88, cancelled Claims 26 and 27, and argued against all objections and rejections previously set forth in the Office Action dated 04/26/2004.

Based on Applicant's amendments, the prior art rejections previously set forth are withdrawn.

Specification

The disclosure is objected to because of the following informalities:

- ❖ The term "five" on Page 6, Line 4 should be amended to – six – because six types of information are subsequently identified (see Specification – Page 6, Lines 6-9).
- ❖ The term "consider" on Page 7, Line 32 should be amended to — considered — so that the sentence is grammatically correct.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

A method of tracking a ~~piece of~~ content and creating new intellectual property comprising:

- receiving an entry of ~~[[a]]~~first ~~piece of~~ content relating to a first piece of intellectual property from a first user;
- storing the first ~~piece of~~ content relating to the first piece of intellectual property with a time stamp and an identifier of the first user;
- preventing any changes to the first ~~piece of~~ content, the time stamp, and the identifier after the first ~~piece of~~ content, the time stamp, and the identifier have been stored~~[[,]]~~;
- reviewing second content relating to a second piece of intellectual property from a second user~~[[,]]~~;
- linking the first content with the second content; and
- combining each of the pieces of intellectual property from each of the users to create new intellectual property.

so that the claim reads more easily and corresponds with subsequent suggested amendments.

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Claim 2 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

The method of claim 1, further comprising:

- presenting a user interface to each of the users through which the ~~piece of~~ content relating to the pieces of intellectual property may be received; and
- crediting each of the users with their contribution to the new intellectual property.

so that the claim corresponds with the previously suggested amendments.

Claim 6 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

The method of claim 1, further comprising:

- designating the first or second ~~piece of~~ content relating to the first and second pieces of intellectual property as having a value to the corresponding user.

so that the claim corresponds with the previously suggested amendments.

Claim 7 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

The method of claim 1, further comprising:

- tracking a value associated with the first or second ~~piece of content~~ relating to the first and second pieces of intellectual property.

so that the claim corresponds with the previously suggested amendments.

Claim 12 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

The method of claim 1, further comprising:

- tracking ~~the~~ an owner of the first or second ~~piece of content~~.

because an “owner” is not previously recited in the claims and so that the claim corresponds with the previously suggested amendments.

Claims 13-17 are objected to because of the following informalities:

- ❖ Claim 13 should be amended to the following:

The method of claim 1, further comprising:

- providing information relating to the first or second ~~piece of~~ content to a trading system.

so that the claim corresponds with the previously suggested amendments. Claims 14-17 have the same problem and should be amended similarly.

Claims 18 and 19 are objected to because of the following informalities:

- ❖ Claim 18 should be amended to the following:

The method of claim 17, wherein the context information identifies a collaborative relationship between the ~~user~~first and second ~~users~~s.

so that the claim corresponds with the previously suggested amendments. Claim 19 has the same problem and should be amended similarly.

Claim 20 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

The method of claim 1, further comprising:

- tracking ~~the~~ an owner of the first or second ~~piece of~~ content.

because an “owner” is not previously recited in the claims and so that the claim corresponds with the previously suggested amendments.

Claim 21 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

The method of claim 1, further comprising:

- maintaining information relating to the first or second user.

because two different “users” are previously recited in the claims and so that the claim corresponds with the previously suggested amendments.

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Claims 22-24 are objected to because of the following informalities:

- ❖ Claim 22 should be amended to the following:

The method of claim 21, wherein the information ~~relating to the user~~ includes personal information.

because two different “users” are previously recited in the claims and so that the claim reads more easily. Claims 23 and 24 have the same problem and should be amended similarly.

Claim 28 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

The method of claim 1, further comprising:

- enabling the first or second ~~piece of~~ content to be linked to a file.

so that the claim corresponds with the previously suggested amendments.

Claims 29-36 and 39 are objected to because of the following informalities:

- ❖ Claim 29 should be amended to the following:

The method of claim 1, further comprising:

- storing the first ~~or second piece of~~ content, the time stamp, and the identifier of the first user with a draft status.

because the claims do not previously recite that the “*second content*” has a “*time stamp*” or an “*identifier of the second user*” and so that the claim corresponds with the previously suggested amendments. Claims 30-36 and 39 have the same problem and should be amended similarly.

Claims 40, 41, 45, 46, 51-63, 67-75 and 78 are objected to because of the following informalities:

- ❖ Claims 40, 41, 45, 46, 51-63, 67-75 and 78 correspond to Claims 1, 2, 6, 7, 12-24, 28-36 and 39, respectively, and should be amended similarly.

Claim 81 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

A system for tracking and creating new intellectual property comprising:

- receiving an entry of a first intellectual property element from a first user; and
- storing the first intellectual property element with a time stamp and an identifier of the first user in a database;
- receiving an entry of a second intellectual property element from a second user;
- storing the ~~first~~ second intellectual property element with a time stamp and an identifier of the second user in the database;
- reviewing the first intellectual property element and the second intellectual property element[[,]];
- linking the first intellectual property element with the second intellectual property element stored in the database; and
- combining the first and second intellectual property elements to create new intellectual property.

to correct an apparent typographic error and so that the claim is properly formatted and reads more easily.

Claim 87 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

[[A]]The system according to of claim 40, wherein the system further comprises:

- a custodian workstation allowing a custodian to verify[[ing]] the integrity of information contained in the system; and
- an administrator workstation which allows the administrator to oversee the users of the system.

so that the claims are consistently formatted, so that the claim is grammatically correct and so that the claim is properly formatted.

Claim 88 is objected to because of the following informalities:

- ❖ The claim should be amended to the following:

A method for tracking and managing a piece of content relating to intellectual property comprising:

- receiving an entry of the piece of content relating to intellectual property from a user;
- storing the piece of content with a time stamp and an identifier of the user;

- preventing any changes to the piece of content, the time stamp, and the identifier after the piece of content, the time stamp, and the identifier have been stored;
- designating the piece of content as having a value to the user; and
- tracking an estimated, market, compound, or a proportional value associated with the piece of content relating to the intellectual property.

so that the claim is properly formatted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38 and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 38 and 77:

Claim 36, from which Claim 38 depends, recites "*submitting the . . . content, the time stamp, and the identifier to a **witness***" (see Claim 36, Lines 1-2), and Claim 38 recites that "*the witness is a **process***" in Line 1. This limitation is indefinite because it is

unclear how a "*process*" can be a witness. Typically, to one of ordinary skill in the art (e.g., a computer programmer who writes software), a "*process*" is considered to be a software module. A software module is not a human being, and the examiner has never heard of anything that is non-human acting as a "witness" for a document.

The examiner notes that the Specification of the present application does not provide any guidance as to how a "*process*" is a "*witness*." In fact, the Specification does not mention that a "*process*" can be a witness. Rather, the Specification indicates only that ***another user*** (i.e., a human being) acts as a "*witness*" (see Page 13, Lines 26-29).

Claim 77 corresponds to Claim 38 and therefore has the same problem.

Applicant must amend the claims to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant may obviate these rejections by canceling the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-6, 12, 14-25, 28-38, 40, 41, 43-45, 51, 53-82 and 85-87 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt et al., U.S. Patent No. 6,418,457 (hereinafter, "Schmidt").

Claim 1:

Schmidt discloses *a method for tracking a piece of content and creating new intellectual property comprising* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system is an electronic replacement for the traditional inventor's notebook. The system comprises a notebook database that stores documents created by inventors and a patent database that allows attorneys to access the documents and use the documents to write patent applications.):

- *receiving an entry of a first piece of content relating to intellectual property from a user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows a first inventor to create and save a first document relating to a first portion of a project. The system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project.);
- *storing the first piece of content relating to intellectual property with a time stamp and an identifier of the user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows the inventors to store the documents that they have created. For each saved document, at the time the document is saved into the system, the system stores the inventor's name and time stamps the document.);

- *preventing any changes to the first piece of content, the time stamp, and the identifier after the first piece of content, the time stamp, and the identifier have been stored* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system permits no alteration of the documents after the documents are time stamped),
- *reviewing content relating to a second piece of intellectual property from a second user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system comprises the patent database, which allows attorneys to access the documents and use the documents to write patent applications),
- *linking the first content with the second content* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system comprises the patent database, which saves all documents associated with the project together as a group) *and*
- *combining each piece of intellectual property from each user to create new intellectual property* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system comprises the patent database, which allows attorneys to access the documents and use the documents to write patent applications).

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Claim 2:

Schmidt discloses *the method of Claim 1, further comprising:*

- *presenting a user interface to the user through which the piece of content relating to intellectual property may be received (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system operates on a computer network and provides user interfaces that allow inventors to create the documents relating to the project and allow other various users to access the documents) and*
- *crediting each user with their contribution to the new intellectual property (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that, for each saved document, the system stores the inventor's name.*

Thereafter, when attorneys create patent applications using the documents, each inventor is credited with their contribution to the invention.).

Claim 4:

Schmidt discloses *the method of Claim 2, wherein the user interface is an email client received (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to access the documents via email).*

Claim 5:

Schmidt discloses *the method of Claim 2, wherein the user interface is presented in a page paradigm (see Column 1, Line 1 through Column 10, Line 19 → Schmidt*

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discloses this limitation in that the system allows inventors to creates the documents using a "notebook" interface).

Claim 6:

Schmidt discloses *the method of Claim 1, further comprising:*

- *designating the first or second piece of content relating to the intellectual property as having a value to the user (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows users to provide independent certification of the storage dates of documents that are deemed to be of exceptional value).*

Claim 12:

Schmidt discloses *the method of Claim 1, further comprising:*

- *tracking the owner of the first or second piece of content (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores the inventor's name for each saved document).*

Claim 14:

Schmidt discloses *the method of Claim 1, further comprising:*

- *providing information relating to the first or second piece of content to a docketing system (see Column 1, Line 1 through Column 10, Line 19 → Schmidt*

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discloses this limitation in that the system stores the documents created by the inventors in the databases).

Claim 15:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining metadata relating to the first or second piece of content to a docketing system* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores data relating to the documents created by the inventors in the databases).

Claim 16:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining log data relating to the first or second piece of content* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system designates the status of documents that are filed as patent applications).

Claim 17:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining context information relating to the first or second piece of content* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the

various projects together as a group and displays to users only those documents in groups to which the users belong).

Claim 18:

Schmidt discloses *the method of Claim 17, wherein the context information identifies a collaborative relationship between the user and second user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and displays to users only those documents in groups to which the users belong).

Claim 19:

Schmidt discloses *the method of Claim 18, wherein the collaborative relationship is a joint project of the user and the second user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and displays to users only those documents in groups to which the users belong).

Claim 20:

Schmidt discloses *the method of Claim 18, further comprising:*

- *controlling access to the first or second piece of information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with the various projects together as a

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group and displays to users only those documents in groups to which the users belong).

Claim 21:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining information relating to the user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores the inventor's name for each saved document and allows users to access only those documents in groups to which the users belong).

Claim 22:

Schmidt discloses *the method of Claim 21, wherein the information relating to the user includes personal information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores the inventor's name for each saved document).

Claim 23:

Schmidt discloses *the method of Claim 21, wherein the information relating to the user includes employment information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system, for each saved document, stores the inventor's name, the subject of the document and the project of the document).

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Claim 24:

Schmidt discloses *the method of Claim 21, wherein the information relating to the user includes functional role information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system, for each employee involved in a project, stores the employee's role in the project).

Claim 25:

Schmidt discloses *the method of Claim 24, further comprising: controlling access to the first or second content based upon the functional role information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system, based upon the employee's role in the project, controls the employee's access to the documents within the project).

Claim 28:

- Schmidt discloses *the method of Claim 1, further comprising:*
- *enabling the first or second piece of content to be linked to a file* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group).

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Claim 29:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first or second piece of content, the time stamp, and the identifier of the user with a draft status* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system includes a “disclosure” section and an “application” section within the patent database).

Claim 30:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first or second piece of content, the time stamp, and the identifier of the user with a registered status* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system includes a “patent” section within the patent database).

Claim 31:

Schmidt discloses *the method of Claim 1, further comprising:*

- *linking the first or second piece of content, the time stamp, and the identifier to other information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group. The documents comprise witness statements and communications with attorneys regarding the creation and filing of patent applications based on the documents.).

Claim 32:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing with the first or second piece of content, the time stamp, and the identifier recovery information identifying the other information (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and allows users to recover those documents).*

Claim 33:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first or second piece of content, the time stamp, and the identifier in a permanent form (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system permits no alteration of the documents and the associated information relating to the documents after the documents are stored).*

Claim 34:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first or second piece of content, the time stamp, and the identifier in a manner that permits the content to be admissible as evidence (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows documents to be certified by Public Notaries).*

Claim 35:

Schmidt discloses *the method of Claim 34, wherein the first or second piece of content, the time stamp, and the identifier are stored such that the first or second piece of content, the time stamp, and the identifier cannot be separated* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and permits no alteration or movement of the documents after the documents are stored).

Claim 36:

Schmidt discloses *the method of Claim 1, further comprising:*

- *submitting the first or second piece of content, the time stamp, and the identifier to a witness* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to attach witness statements to the documents).

Claim 37:

Schmidt discloses *the method of Claim 36, wherein the witness is a third party* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to attach witness statements to the documents and allows documents to be certified by Public Notaries).

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Claim 38:

Schmidt discloses *the method of Claim 36, wherein the witness is a process* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to attach witness statements to the documents and allows documents to be certified by Public Notaries).

Claims 40, 41, 43-45, 51, 53-64 and 67-77:

Claims 40, 41, 43-45, 51, 53-64 and 67-77 merely recite a system for performing the method recited in Claims 1, 2, 4-6, 12, 14-25 and 28-38, respectively. Thus, Schmidt discloses every limitation of Claims 40, 41, 43-45, 51, 53-64 and 67-77, as indicated in the above rejections for Claims 1, 2, 4-6, 12, 14-25 and 28-38.

Claim 65:

Schmidt discloses *the system of Claim 40, wherein the server also enables the first or second piece of content to be linked to another piece of content that is already stored is a process* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system comprises a computer network including nodes and servers that saves all documents associated with each of the various projects together as a group).

Claim 66:

Schmidt discloses *the system of Claim 65, wherein the other piece of content was created by another user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves documents, created by multiple users and associated with one project, together as a group).

Claim 79:

Schmidt discloses *the method of Claim 1, wherein the first or second piece of intellectual property is at least one idea, invention, patent, trademark or copyright* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation, as clearly indicated in the cited text).

Claim 80:

Schmidt discloses *the method of Claim 1, wherein the new intellectual property is at least one idea, invention, patent, trademark or copyright* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation, as clearly indicated in the cited text).

Claims 81, 82, 85 and 86:

Claims 81, 82, 85 and 86 correspond to Claims 66, 41, 79 and 80, respectively. Thus, Schmidt discloses every limitation of Claims 81, 82, 85 and 86, as indicated in the above rejections for Claims 66, 41, 79 and 80.

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Claim 87:

Schmidt discloses a system according to Claim 40, wherein the system further comprises:

- *a custodian workstation allowing a custodian to verifying the integrity of information contained in the system (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to attach witness statements to the documents and allows documents to be certified by Public Notaries); and*
- *an administrator workstation which allows the administrator to oversee the users of the system (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system includes an administrator).*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt, in view of Hirota et al., U.S. Patent No. 6,868,402 (hereinafter, "Hirota").

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Claim 3:

As indicated in the above rejection, Schmidt discloses every limitation of Claim 1.

Schmidt fails to expressly disclose:

- *[a] user interface [that] is a Web page.*

Hirota teaches a method for submitting an intellectual property document via the Internet (see Column 8, Lines 28-30 → Hirota teaches this limitation, as clearly indicated in the cited figure and text), comprising:

- *presenting a user interface to a user through with a piece of content relating to intellectual property may be received, wherein the user interface is a Web page*

(see Column 8, Lines 28-30; see Column 21, Lines 25-28 → Hirota teaches these limitations, as clearly indicated in the cited figure and text),
for the purpose of providing a system that allows client users to submit documents remotely (see Column 3, Lines 8-11).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Schmidt, to include:

- *[a] user interface [that] is a Web page,*

for the purpose of providing a system that allows client users to submit documents remotely, as taught by Hirota.

Claim 42 merely recites a system for performing the method recited in Claim 3. Thus, Schmidt, in view of Hirota, discloses/teaches every limitation of Claim 42 and provides proper reasons to combine, as indicated in the above rejection for Claim 3.

Claims 7-11, 46-50, 83, 84 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt, in view of Carter, U.S. Patent No. 6,665,656 (hereinafter, "Carter").

Claim 7:

As indicated in the above rejection, Schmidt discloses every limitation of Claim 1.

Schmidt fails to expressly disclose:

- *tracking a value associated with the first or second piece of content relating to the intellectual property.*

Carter teaches a method for determining values of multiple pieces of intellectual property and tracking the values over time (see Figure 1; see Column 2, Line 16 through Column 6, Line 40 → Carter teaches this limitation, as clearly indicated in the cited figure and text), comprising:

- *designating a first or second piece of content relating to intellectual property as having a value to a user (see Figure 1; see Column 2, Line 16 through Column 6,*

Line 40 → Carter teaches this limitation in that the system determines values of intellectual property assets); and

- *tracking a value associated with the first or second piece of content relating to the intellectual property* (see Figure 1; see Column 2, Line 16 through Column 6,

Line 40 → Carter teaches this limitation in that the system tracks the values of the intellectual property assets over time),

for the purpose of determining whether the values of the pieces of intellectual property are increasing or decreasing over time (see Column 6, Lines 3-7).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Schmidt, to include:

- *tracking a value associated with the first or second piece of content relating to the intellectual property,*

for the purpose of determining whether the values of the pieces of intellectual property are increasing or decreasing over time, as taught by Carter.

Claims 8 and 9:

Schmidt fails to expressly disclose:

- *a value [that] is an estimated value; and*
- *a value [that] is a market value.*

Carter teaches:

- *a value [that] is an estimated value* (see Figure 1; see Column 2, Line 16 through Column 6, Line 40 → Carter teaches this limitation in that the system determines estimated market values of the intellectual property assets); *and*
- *a value [that] is a market value* (see Figure 1; see Column 2, Line 16 through Column 6, Line 40 → Carter teaches this limitation in that the system determines estimated market values of the intellectual property assets),

for the purpose of improving the asset-based decision making process within an organization (see Column 5, Lines 41-47).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Schmidt, to include:

- *a value [that] is an estimated value; and*
- *a value [that] is a market value,*

for the purpose of improving the asset-based decision making process within an organization, as taught by Carter.

Claims 10 and 11:

Schmidt fails to expressly disclose:

- *a value [that] is a compound value; and*
- *a value [that] is a proportional value.*

Carter teaches:

- *a value [that] is a compound value* (see Figure 1; see Column 2, Line 16 through Column 6, Line 40 → Carter teaches this limitation in that the system determines the value of a single intellectual property asset or the values of multiple intellectual property assets); *and*
- *a value [that] is a proportional value* (see Figure 1; see Column 2, Line 16 through Column 6, Line 40 → Carter teaches this limitation in that the system determines the value of a single intellectual property asset or the values of multiple intellectual property assets),

for the purpose of improving the asset-based decision making process within an organization (see Column 5, Lines 41-47).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Schmidt, to include:

- *a value [that] is a compound value; and*
- *a value [that] is a proportional value,*

for the purpose of improving the asset-based decision making process within an organization, as taught by Carter.

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Claims 46-50:

Claims 46-50 merely recite a system for performing the method recited in Claims 7-11. Thus, Schmidt, in view of Carter, discloses/teaches every limitation of Claims 46-50 and provides proper reasons to combine, as indicated in the above rejections for Claims 7-11.

Claims 83 and 84:

Claims 83 and 84 correspond to Claims 46-50. Thus, Schmidt, in view of Carter, discloses/teaches every limitation of Claims 83 and 84 and provides proper reasons to combine, as indicated in the above rejections for Claims 46-50.

Claim 88:

Claim 88 corresponds to Claims 6 and 7. Thus, Schmidt, in view of Carter, discloses/teaches every limitation of Claim 88 and provides proper reasons to combine, as indicated in the above rejections for Claims 6 and 7.

Claims 13 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt, in view of <http://web.archive.org/web/19991115094516/http://www.techex.com>, archived on 11/15/1999 (hereinafter, "Techex").

Claim 13:

As indicated in the above rejection, Schmidt discloses every limitation of Claim 1.

Schmidt fails to expressly disclose:

- *providing information relating to the first or second piece of content to a trading system.*

Techex teaches a method for providing a business-to-business extranet for technology licensing professionals (see Pages 1-9 → Techex teaches this limitation, as clearly indicated in the cited pages), comprising:

- *providing information relating to a first or second piece of content to a trading system* (see Pages 1-9 → Techex teaches this limitation in that the system allows research institutions to send descriptions of available technology to technology licensing professionals),

for the purpose of providing marketing opportunities to inventors (see Pages 1-9).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Schmidt, to include:

- *providing information relating to the first or second piece of content to a trading system,*

for the purpose of providing marketing opportunities to inventors, as taught by Techex.

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Claim 52:

Claim 52 merely recites a system for performing the method recited in Claim 13. Thus, Schmidt, in view of Techex, discloses/teaches every limitation of Claim 52 and provides proper reasons to combine, as indicated in the above rejection for Claim 13.

Claims 39 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt, in view of Serbinis et al., U.S. Patent No. 6,314,425 (hereinafter, "Serbinis").

Claim 39:

As indicated in the above rejection, Schmidt discloses every limitation of Claim 1.

Schmidt fails to expressly disclose:

- *generating a digital fingerprint for the first or second content, the time stamp, and the identifier; and*
- *storing the digital fingerprint.*

Serbinis teaches a method for providing an Internet-based document management system (see Column 1, Lines 11-14 → Serbinis teaches this limitation, as clearly indicated in the cited text), comprising:

- generating a digital fingerprint for a document (see Column 9, Lines 32-44 → Serbinis teaches this limitation, as clearly indicated in the cited text); and

- storing the digital fingerprint and a timestamp with the document (Serbinis teaches this limitation, as clearly indicated in the cited text),

for the purpose of enabling the transaction logging capabilities and providing the access-control protocols needed for multi-user collaborative electronic document manipulation (see Column 3, Lines 36-49).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Schmidt, to include:

- *generating a digital fingerprint for the first or second content, the time stamp, and the identifier; and*
- *storing the digital fingerprint,*

for the purpose of enabling the transaction logging capabilities and providing the access-control protocols needed for multi-user collaborative electronic document manipulation, as taught by Serbinis.

Claim 78:

Claim 78 merely recites a system for performing the method recited in Claim 39. Thus, Schmidt, in view of Techex, discloses/teaches every limitation of Claim 78 and provides proper reasons to combine, as indicated in the above rejection for Claim 39.

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Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
May 4, 2007


Doug Hutton
Primary Examiner
Technology Center 2100